

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of: Mark Falahee

Application No.: 10/689,124

Confirmation No.: 2910

Filed: October 20, 2003

Art Unit: 3734

For: RADIOPAQUE MARKING PEN

Examiner: D. Yabut

APPELLANT'S REPLY BRIEF

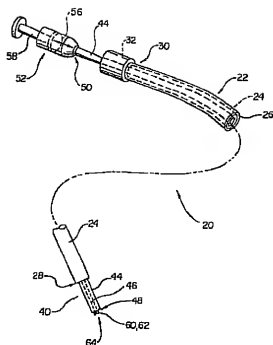
Mail Stop APPEAL BRIEF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

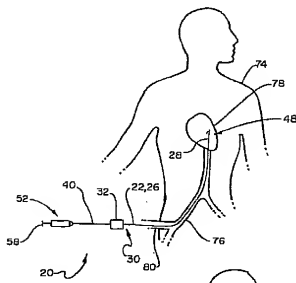
In response to new arguments raised in the Examiner's Answer mailed September 3, 2008, Appellant hereby submits its Reply Brief.

The Examiner states on page 2 of the Answer that "the device in Figure 1 of Palassis is [a] pen-shaped member 22 with a reservoir and a distal tip through which a substance is dispensed to mark tissue, and therefore the device of Palassis reads on this ordinary and customary definition [of a marking pen]." (Examiner's Answer, bottom of page 2, top of page 3) Again, Appellant urges that such an interpretation of Palassis is unreasonable.

Figure 1 of Palassis is shown below:



Item 22 is a *flexible hose*. Judging by Figure 6 of Palassis, also shown below, the hose has a length of several feet. A flexible hose in the range of several feet would not be considered “pen-shaped” by anyone.



The Examiner’s argument that the device of Palassis includes “a distal tip through which a substance is dispensed to mark tissue.” is also incorrect. According to the reference, a limitation to previous methods of delivering therapeutic agents to the heart “is that the injected fluid tends to leak

and/or disperse from the site of the injection after the needle is disengaged from the heart. In fact, fluid may continue to leak over several seconds. In the case of dynamic organs such as the heart, there may be more pronounced leakage with each muscle contraction.” (‘103 Patent, 1:34-41)

In response, the Examiner argues that “the fluid [of Palassis] is still capable of marking, or making a visible trace or impression of the fluid on skin or surgical film after being dispensed.” (Examiner’s Answer, top of page 3) The Examiner has presented no proof whatsoever that the fluid of Palassis is capable of “marking.” Fluid, possibly clear, dripping over a surface in an uncontrolled manner would not be considered “marking.”

Nor does Palassis teach the limitation of “a reservoir *in the housing*...” According to the reference, “[a] fluid source 52 is releasably connected to the proximal end 50 of injection catheter 40. Fluid source 52 in [sic] fluid communication with lumen 46 of elongate tubular member 44. Fluid source 52 is capable of injecting fluid into lumen 46 of elongate tubular member 44.” (See ‘103 Patent, 5:20-25 and Figures, above.)

With regard to claims 9 and 14, the Examiner now argues that it would be obvious to provide Palasis with a powered substance and mark a surgical film on the grounds that it would be “easily removed from the surgical site being x-rayed, and not necessarily requiring penetration of the skin.” (Examiner’s Answer, bottom of page 3) However, the Examiner presents no evidence that a power would be “easily removed from the surgical site being x-rayed,” or whether “easy removal is at issue. Nor does the Examiner provide any support for “requiring penetration of the skin.” Skin penetration is also not a central issue.

The method of claim 13 sets forth the additional step of erasing the indication if not optimized for the procedure. The Examiner now argues, essentially, that ‘erasing mistakes is well known.’ (Examiner’s Answer, top of page 4) While erasing may be well know for math homework, it is not well for erasing marks made on a human body and, in any case, the Examiner’s argument does not provide *prima facie* evidence for the additional teachings of DeSena.

Dated: Nov. 3, 2008

Respectfully submitted,

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